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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/699,209	10/27/2000	Takefumi Nagumo	450100-02802	8273

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NEW YORK, NY 10151

EXAMINER
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RAO, ANAND SHASHIKANT

ART UNIT	PAPER NUMBER
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2613

DATE MAILED: 03/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/699,209

Applicant(s)

NAGUMO ET AL.

Examiner

Andy S. Rao

Art Unit

2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 2613

## **DETAILED ACTION**

### ***Response to Amendment***

1. As per the Applicant's instructions filed in Paper 7 on 12/17/03 claims 14-28 have been added.
2. Applicant's arguments with respect to claims 1-28 as filed in Paper 7 on 12/17/03 have been considered but are moot in view of the new ground(s) of rejection based on newly cited portions of the previously applied references addressing the newly added limitations.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Negishi.

Art Unit: 2613

Negishi discloses a signal processing device for multiplexing first and second bit streams, each of said first and second bit streams being formatted in accordance with a different standard (Negishi: column 1, lines 23-28: MPEG1 and MPEG2), comprising: a dividing means for dividing said second bit stream into predetermined units (Negishi: column 3, lines 10-25); an adding means for adding a start code (Negishi: column 3, lines 25-35) in a format corresponding to the standard of the first bit stream (Negishi: column 3, lines 3-7), each of said units obtained by dividing said second bit stream (Negishi: column 5, lines 45-55); and a multiplexing means for defining a user operable region in said first bit stream and multiplexing and recording at least a part of said second bit stream on said user operable region (Negishi: column 8, lines 45-60), as in claim 1.

Regarding claim 2, Negishi discloses that start code includes time information (Negishi: column 3, lines 215-35; column 6, lines 15-23), as claimed.

Regarding claim 3, Negishi discloses that the time information is the display time or decoding time (Negishi: column 5, lines 35-40), as in the claim.

Regarding claim 4, Negishi disclose that the dividing means divides said bit stream into units if frames or those of a plurality of frames (Negishi: column 1, lines 34-59), as in the claim.

Negishi discloses a signal processing method for multiplexing first and second bit streams, each of said first and second bit streams being formatted in accordance with a different standard (Negishi: column 1, lines 22-28), comprising: a dividing step for dividing said second bit stream into predetermined units (Negishi: column 3, lines 10-25); an adding step for adding a start code (Negishi: column 3, lines 25-35) in a format corresponding to the standard of said first bit stream (Negishi: column 3, lines 3-6) to each of said units obtained by dividing said second

Art Unit: 2613

bit stream (Negishi: column 5, lines 45-55); and a multiplexing step for defining a user operable region in said first bit stream and multiplexing and recording at least a part of said second bit stream on said user operable region (Negishi: column 8, lines 45-60), as in claim 5.

Regarding claim 6, Negishi discloses that start code includes time information (Negishi: column 3, lines 15-35; column 6, lines 15-23), as claimed.

Regarding claim 7, Negishi discloses that the time information is the display time or decoding time (Negishi: column 5, lines 35-40), as in the claim.

Regarding claim 8, Negishi disclose that the dividing means divides said bit stream into units if frames or those of a plurality of frames (Negishi: column 1, lines 34-59), as in the claim.

Negishi discloses a recording medium for storing a program for multiplexing first and second bit streams (Negishi: column 8, lines 20-40), each of said first and second bit streams being formatted in accordance with a different standard (Negishi: column 1, lines 22-28), comprising: a dividing step for dividing said second bit stream into predetermined units (Negishi: column 3, lines 10-25); an adding step for adding a start code (Negishi: column 3, lines 25-35) in a format corresponding to the standard of the first bit stream (Negishi: column 3, lines 3-6) to each of said units obtained by dividing said second bit stream (Negishi: column 5, lines 45-55); and a multiplexing step for defining a user operable region in said first bit stream and multiplexing and recording at least a part of said second bit stream on said user operable region (Negishi: column 8, lines 45-60), as in claim 9.

Regarding claim 10, Negishi disclose that the dividing means divides said bit stream into units if frames or those of a plurality of frames (Negishi: column 1, lines 34-59), as in the claim.

Art Unit: 2613

Negishi discloses a decoding device adapted to decode a multiplexed bit stream (Negishi: column 1, lines 30-60), conforming to a first standard (Negishi: column 1, lines 22-28), comprising: a means for detecting the user operable region in said in said multiplexed bit stream (Negishi: column 8, lines 45-60) and extracting the data contained in said user operable region (Negishi: column 6, lines 10-23):a converting means for conducting a predetermined converting operation on said data contained in said user operable region and restoring the second bit stream (Negishi: column 1, lines 50-60; column 3, lines 10-25) conforming to a second standard different from said first standard format (Negishi: column 1, lines 45-50), said second bit stream also conforming to a syntax of said first standard format (Negishi: column 3, lines 3-6); and a decoding means for decoding said first bit stream contained in said multiplexed bit stream except said user operable region and said second bit stream (Negishi: column 2, lines 1-35), means for as in claim 11.

Negishi discloses a decoding method adapted to decode a multiplexed bit stream (Negishi: column 1, lines 30-60), conforming to a first standard (Negishi: column 1, lines 22-28), comprising: a step for detecting the user operable region in said in said multiplexed bit stream (Negishi: column 8, lines 45-60) and extracting the data contained in said user operable region (Negishi: column 6, lines 10-23):a converting step for conducting a predetermined converting operation on said data contained in said user operable region and restoring the second bit stream (Negishi: column 1, lines 50-60; column 3, lines 10-25) conforming to a second standard different from said first standard format (Negishi: column 1, lines 45-50), said second bit stream also conforming to a syntax of said first standard format (Negishi: column 3, lines 3-6); and a decoding step for decoding said first bit stream contained in said multiplexed bit stream except

Art Unit: 2613

said user operable region and said second bit stream (Negishi: column 2, lines 1-35), means for as in claim 12.

Negishi discloses a recording medium storing a program for decoding a multiplexed bit stream (Negishi: column 1, lines 30-60), conforming to a first standard (Negishi: column 1, lines 22-28), said program comprising: a step for detecting the user operable region in said in said multiplexed bit stream (Negishi: column 8, lines 45-60) and extracting the data contained in said user operable region (Negishi: column 6, lines 10-23); a converting step for conducting a predetermined converting operation on said data contained in said user operable region and restoring the second bit stream (Negishi: column 1, lines 50-60; column 3, lines 10-25) conforming to a second standard different from said first standard format (Negishi: column 1, lines 45-50), said second bit stream also conforming to a syntax of said first standard format (Negishi: column 3, lines 3-6); and a decoding step for decoding said first bit stream contained in said multiplexed bit stream except said user operable region and said second bit stream (Negishi: column 2, lines 1-35), means for as in claim 13.

Regarding claim 14, Negishi discloses that the units of said second bits stream conform to a syntax of said first bit stream (Negishi: column 3, lines 3-60), as in the claim.

Regarding claim 15, Negishi discloses that the units of said second bit stream cannot be processed by a processor processing said first bit stream (Negishi: column 1, lines 20-30: MPEG1 processors cannot decode MPEG2 streams), as in the claims.

Regarding claims 16-18, Negishi discloses that the first bit stream is MPEG2 (Negishi: column 3, lines 3-6), as in the claims.

Art Unit: 2613

Regarding claim 19, Negishi discloses that the units of said second bits stream conform to a syntax of said first bit stream (Negishi: column 3, lines 3-60), as in the claim.

Regarding claim 20, Negishi discloses that the units of said second bit stream cannot be processed by a processor processing said first bit stream (Negishi: column 1, lines 20-30: MPEG1 processors cannot decode MPEG2 streams), as in the claims.

Regarding claims 21-23, Negishi discloses that the first bit stream is MPEG2 (Negishi: column 3, lines 3-6), as in the claims.

Regarding claim 24, Negishi discloses that the units of said second bits stream conform to a syntax of said first bit stream (Negishi: column 3, lines 3-60), as in the claim.

Regarding claim 25, Negishi discloses that the units of said second bit stream cannot be processed by a processor processing said first bit stream (Negishi: column 1, lines 20-30: MPEG1 processors cannot decode MPEG2 streams), as in the claims.

Regarding claims 26-28, Negishi discloses that the first bit stream is MPEG2 (Negishi: column 3, lines 3-6), as in the claims.

### *Conclusion*

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after



Art Unit: 2613

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andy S. Rao whose telephone number is (703)-305-4813. The examiner can normally be reached on Monday-Friday 8 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris S. Kelley can be reached on (703)-305-4856. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andy S. Rao  
Primary Examiner  
Art Unit 2613

ANDY RAO  
PRIMARY EXAMINER

asr

March 12, 2004